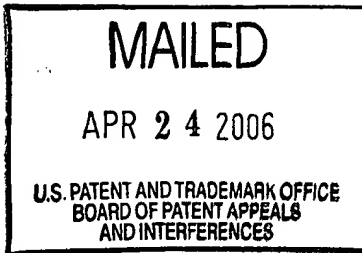


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD OLIVER KAHN  
and  
ANDREW ARTHUR HUNTER

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Application 09/788,669

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on April 10, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that appellants filed an Appeal Brief on October 25, 2005 using the format set forth in 37 CFR § 41.37(c). However, the Appeal Brief does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

. . . . .

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

. . . . .

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

. . . . .

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief:

- 1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

A supplemental brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled "More Information on the Rules

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of Practice Before the Board of Patent Appeals and Interferences,  
Final Rule" located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

In addition, pursuant to a memorandum dated April 29,  
2002 by Stephen G. Kunin, Deputy Commissioner for Patent  
Examination Policy:

Effective immediately, no appeal should be  
forwarded to the Board of Patent Appeals and  
Interferences for decision where: . . . (2) a  
rejection is supported in whole or part by a  
prior art document not in the English  
language, unless accompanied by a translation  
of the prior art document into English.

The IFW is not in compliance with the above because it does not  
contain an English translation of Japanese reference to Imai,  
No. 09-128276, dated May 16, 1997, which was relied upon by the  
Examiner in his rejection of the claims.

Accordingly, it is

ORDERED that the application is returned to the

Examiner:

1) to hold the Appeal Brief filed October 25, 2005<sup>1</sup>  
defective;

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<sup>1</sup> It should be noted that the Appeal Brief was resubmitted on  
March 13, 2006 because the final page of the Appendix was  
inadvertently omitted from the original Appeal Brief (as noted  
by page 3 of the Examiner's Answer mailed January 12, 2006).

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2) for notification to appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;

3) for consideration of the supplemental Appeal Brief, and, if necessary, to vacate the Examiner's Answer mailed January 12, 2006, and issue a revised Examiner's Answer;

4) for providing a certified English language translation for the Japanese reference to Imai, No. 9-128176, dated May 16, 1997;

5) for written notification to appellants regarding the action taken; and

6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

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